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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/998,302	12/24/97	STANFIELD	J STE01-P798B

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EXAMINER

ZIMMERMAN, B

ART UNIT

PAPER NUMBER

2735

DATE MAILED: 08/31/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/998,302	Applicant(s) Stanfield
	Examiner Brian Zimmerman	Group Art Unit 2735



Responsive to communication(s) filed on Jul 6, 1998.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1, 12, 13, 19, 23, 34-38, and 54 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1, 12, 13, 19, 23, 34-38, and 54 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

EXAMINER'S RESPONSE

Status of Application.

1. In response to the applicant's election and amendment received on 7/6/98. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1,12,13,19,23,34-38,54 are unpatentable for the reasons set forth in this office action:

INFORMALITIES

- 10 2. Applicant's election with traverse of Group VII (claims 1,12,13,19,23,34-38,54) is acknowledged.

The restriction requirement is upheld for at least the following. Examples of distinctness between the subcombinations have been shown in paragraph #2 Office Action 6/8/98. Merely because all the claimed species can operate in the same system is not evidence that the species are not mutually exclusive.

- 15 3. This application contains claims drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

CLAIMS

4. The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
5 and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).

10 A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be
commonly owned with this application. See 37 CFR 1.130(b).

15 Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply
with 37 CFR 3.73(b).

20 5. Claims 1,12,13,19,23,34,54 are rejected under the judicially created doctrine of
double patenting over claims 1-20 of U. S. Patent No. 5751221 since the claims, if
allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the
patent and is covered by the patent since the patent and the application are claiming
common subject matter, as follows: a file tracking system including a folder (file) with
conductors to communicate to the folder.

25 Furthermore, there is no apparent reason why applicant was prevented from
presenting claims corresponding to those of the instant application during prosecution
of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158
USPQ 210 (CCPA 1968). See also MPEP § 804.

ART REJECTION

6. Claims 1,12,13,19,23,34,54 are rejected under 35 U.S.C. § 103 as being unpatentable over Smith 5455409 and Kott 4376936 and Foster 5287414.

Smith shows a file tracking system in which a processor is connected to a bus which is connected to a folder retainer 12. the processor sends information to a folder such that a indicator displays the lactation of the folder to a user requesting to know the location of the folder. Smith discloses that the use of a data base to maintain the location information is an alternative to the distributed database system. The examiner takes official notice that the use of a personal computer or computers on a LAN are common processor system available to the artisan.

In an analogous art, Kott shows a filed folder which is addressed by a conductive bus. The folder includes an address, a comparator and a light indicator to assist the user in locating the file. The examiner takes official notice that the use of a transistor to operate a light indicator in the manner claimed is verily common in the art, to isolate the lamp/light from the switch. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Kott to store documents in a filing system which can locate the folders in the manner suggested by Smith.

In an analogous art, Foster shows multiple addressable cabinets can be used to store folders. The cabinets include indicators to tell the user which cabinet houses the folder which the user is trying to locate. Therefore, it would have been obvious to one

of ordinary skill in the art at the time of the invention to have utilized multiple addressable cabinets, each with an addressable indicator to assist the user in locating a folder in the above modified system.

- 5 7. Claims 35-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

REMARKS

- 10 **Response to Arguments.**

The following discussion is introduced in direct response to the arguments presented in the instant amendment:

It is pointed out that Smith does in fact disclose the use of a central database in a file retrieval system, however Smith chooses not to utilize such a database. See abstract. From this suggestion, the skilled artisan would reliably be able to efficiently update and manage a database of information.

It is pointed out that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art.

Kott does show a device which is responsive to being addressed, and Smith

shows a signal being sent to the central database for maintenance of an up to date location database (see col. 3 lines 5-40).

CONTACT INFORMATION

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Zimmerman whose telephone number is (703) 305-4796.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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Brian Zimmerman
Patent Examiner
Art Unit 2735

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703-305-4796
August 25, 1998